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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/345,202 | 06/30/1999 | DAVID A. MARTIN | 0236.0006 | 9944 |

26781 7590 07/13/2005

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EXAMINER

PATEL, JAGDISH

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| ART UNIT | PAPER NUMBER |
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3624

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/345,202

Applicant(s)

MARTIN, DAVID A.

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-12, 14, 15, 20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6-12, 14, 15, 20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

DETAILED ACTION

Response to Arguments

1. In view of the appeal brief filed on 10/23/2003, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. Applicant's arguments, with respect to the rejection(s) of pending claim(s) under 35 USC 103 have been fully considered and are persuasive. Therefore, the finality of the previous office action and rejection thereof have been withdrawn.

Claim Rejections - 35 USC § 112

3. Claim 1, 6-12, 14-15, 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 recites the limitation "the bank" in lines 10 and 11. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 1 recites limitation "electronically transferring the account number, the routing number, and at the at least one piece of information to the bank" which does not functionally relate to the "paying the check" limitation because the latter is performed is performed independent of the transferred information.

6. Since the barcode contains some or all of the same information as that printed on the check (for example, the bar code contains at least one of the piece of information printed on the check), the condition "if the information printed on the check is identical to the at least one of the piece of information on the bar code" is always "true" or positive. Based on this analysis the check is always paid when presented to the

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bank. This defect renders the claimed invention as indefinite as to how it prevents the check fraud as claimed.

7. Claim 6 is rendered indefinite for at least the following reasons:

7.1 Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

7.2 Those steps which are essential to enable the "viewing" of the at least one negotiable instrument such as those recited in claim 7.

7.3 Not that the phrase "to be viewed on a global computer network" is only intended function. The claim does not recite any step(s) which actually carry out process which is required so that the viewing step is enabled.

7.4 "which of the lest one negotiable instruments" lack proper antecedent basis because the delivery step is not recited in plurality of negotiable instruments.

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7.5 the limitation "the drawer" lack proper antecedent basis in the claim because "drawer's account" is distinct from the drawer. The drawer must have access to the global communication network and access to the negotiable instruments presented to the drawee must be provided to the drawer for viewing via the global communication network. The claimed invention fails to recite any step(s) which render this critical functionality.

8. Claims 10-12 and 14 are rendered indefinite for at least the following reasons:

8.1 The preamble of the claim recites "a method of preventing fraud", however, the claim as a whole fails to accomplish this intended function. (applies to Claims 10 and 11)

8.2 claim 10 is rejected as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See **MPEP § 2172.01**. see explanation below.

8.3 the claim recites the steps of "creating at least one negotiable instrument" and "attaching the machine readable code.." which have no functional relationship to the following steps of "electronically transferring" and "entering ..into database". Therefore, it is not clear what the claimed invention is directed to.

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8.4 Dependent claim 11 fails to remedy the problem recited above. This claim recites functions, which are carried out without any functional relationship to those functions recited in the parent claim 10.

For example, receiving and scanning steps are performed regardless of the attaching step.

8.5 Limitations of claim 12 recites process steps which are carried out independent of those preceding it. For example, while claim 12 depends upon claims 10 and 11 none of the limitations of these claims have any functional relationship to claim 12 limitations.

9. Claims 20 and 23 are rendered indefinite for at least the following reasons:

9.1 limitations "the drawee bank" lack proper antecedent basis in the claim.

9.2 the claim refers entity "a payee" and "the payee" numerous times (see lines 5-6, 10, 14 and 16). Is the claim referring to only one payee or more than one payees? If the payees are distinct the claim must clearly recite the difference.

9.3 The claim refers to "electronically transferring the information to the drawee bank". It is not clear how this step relates to the other information transferred to the drawee

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bank in step "having the payee bank electronically transfer...". It appears that the former step is redundant and should be deleted.

10. Note that dependent claims contain deficiencies as discussed in the analysis presented above.

Allowable Subject Matter

11. The pending claims would be considered for allowance subject to correction of the deficiencies discussed in this office action.

Conclusion

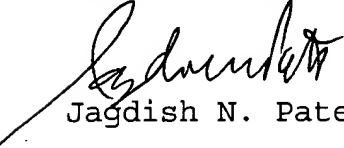
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571)272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

7/5/05